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Brent Magouirk

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EXAMINER

LOFTIS, JOHNNA RONEE

ART UNIT

PAPER NUMBER

3624

NOTIFICATION DATE

DELIVERY MODE

11/09/2009

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPTO@hershkovitz.net  
patent@hershkovitz.net

|                              |                                      |                                       |  |
|------------------------------|--------------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/052,577 | <b>Applicant(s)</b><br>MAGUIRK ET AL. |  |
|                              | <b>Examiner</b><br>JOHNNA R. LOFTIS  | <b>Art Unit</b><br>3624               |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2,4-8,13,17-20 and 26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-8,13,17-20 and 26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)         | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)         | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                          |

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***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/27/09 has been entered.
2. Claims 3, 9-12, 14-16 and 21-25 have been cancelled. Claims 1, 2, 4-8, 13, 17-20 and 26 are pending and have been examined on the merits discussed below.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
4. Claims 1, 17 and 20 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims recite a non-purchaser is other than said current customer and past purchasers. This limitation is not supported by the specification. Any negative limitation or exclusionary provision must have basis in the original disclosure. If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See In re

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Johnson, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) (“[the] specification, having described the whole, necessarily described the part remaining.”). See also Ex parte Grasselli, 231 USPQ 393 (Bd. App. 1983), aff’d mem., 738 F.2d 453 (Fed. Cir. 1984). The mere absence of a positive recitation is not basis for an exclusion. MPEP 2173.05(i).

### ***Response to Arguments***

5. Applicant's arguments with respect to claims amended with the feature “between a plurality of dealers of a single sales entity” have been considered but are moot in view of the new ground(s) of rejection.

6. Applicant's arguments filed 8/27/09 have been fully considered but they are not persuasive. Applicant argues the cited references do not teach data representing historical interactions *between a plurality of dealers of a single sales entity*. Examiner respectfully disagrees. Stack is a sales entity that sells items from a plurality of companies (dealers). Since Stack is directed toward a sales entity selling various items from a plurality of companies,

7. Applicant's arguments filed with respect to the specific data that is analyzed have been fully considered but they are not persuasive. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability,

8. Applicant's arguments filed with respect to Examiner's taking of Official notice have been fully considered but they are not persuasive. Regarding official notice taken based on the rescheduling or re-assigning tasks if not performed as scheduled, Applicant has attempted to

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challenge the Examiner's taking of Official Notice. There are minimum requirements for a challenge to Official Notice:

(a) In general, a challenge, to be proper, must contain adequate information or arguments so that *on its face* it creates a reasonable doubt regarding the circumstances justifying the Official Notice

(b) Applicants must seasonably traverse (challenge) the taking of Official Notice as soon as practicable, meaning the next response following an Office Action. If an applicant fails to seasonably traverse the Official Notice during examination, his right to challenge the Official Notice is waived. Emphasis Added

Examiner notes that Official Notice for these claim limitations was taken for the first time in the action dated June 30, 2006. Applicant's lack of traversal in the subsequent office action waives his right to challenge the Official notice. Per MPEP 2144.03(c), these statements are taken as admitted prior art because no traversal of this statement was made in the subsequent response. Specifically, it has been taken as prior art that: based on teachings in Geerlings, it would have been obvious to generate a trigger wherein if a communication is not sent as scheduled, i.e., network error, the communication is rescheduled to be sent..

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***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. **Claims 1, 2, 4-8, 13, and 26** rejected under 35 U.S.C. 103(a) as being unpatentable over Stack, US6782370, in view of Geerlings, US 5956693, further in view of Kramer et al, US 6,327,574.

As per **claim 1**, Stack teaches statistically analyzing a collection of data representing historical interactions between a plurality of dealers of a single sales entity with a plurality of previous customers that include at least one purchaser and at least one non-purchaser (column 1, lines 43-67 – collection of potential customer interest in a good and/or service and also collection of previous customer purchasing history; column 3, the system is a sales entity selling items from several different book companies (dealers); column 3, lines 50-65 – confidence matching factor is calculated to determine recommendations); developing at least one recommended action item to be taken with respect to a current customer based on results of the statistical analysis (column 1, lines 43-67 and column 2, lines 32-67 – interest data and purchasing data are analyzed to produce recommendations); wherein at least one of said at least one non-purchaser is other than said current customer and past purchasers (column 1, lines 43-67 – collection of potential customer interest in a good and/or service and also collection of previous customer purchasing history).

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While Stack teaches generating recommendations (column 3 and 4), the reference fails to explicitly teach selecting an appropriate task type and automatically updating an electronic schedule with at least one task representing the at least one recommended action item. Geerlings teaches this feature (column 4, line 58 – column 5, line 5 – customer activity is analyzed and a plan is formulated by the merchant for desired customer communications, the plan including the desired communication (mail, email, internet, fax, etc.; column 4, line 58 – column 5, line 5 – customer activity is analyzed and a plan is formulated by the merchant for desired customer communications, the plan including the desired communication (mail, email, internet, fax, etc.) and the date or timing of when the communication is to be sent, rules for sending offers are based on the product purchased, i.e., if a customer purchases a certain appliance and extended warranty offer is sent to the customer and the date or timing of when the communication is to be sent). It would have been obvious to one of ordinary skill in the art to include in the recommendation system of Stack the scheduling of communications regarding the recommendations as taught by Geerlings since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Stack, in combination of Geerlings, teaches scheduling desired communication (mail, email, internet, fax, etc.) and the date or timing of when the communication is to be sent based on the product purchased (Geerlings, column 4, line 58 – column 5, line 5), but does not explicitly teach automatically rescheduling the task if it is not performed as scheduled.

Geerlings however teaches generating trigger statements wherein a criterion is set that triggers an

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action, i.e., send a communication after a predetermined amount of time. In view of the triggers in Geerlings, official notice is taken that it would have been obvious to one of ordinary skill in the art at the time of the invention to generate a trigger wherein if a communication is not sent as scheduled, i.e., network error, the communication is rescheduled to be sent. This would ensure communications to customers are sent regardless of any glitch in the system.

Further Stack teaches analyzing customer data, but does not explicitly teach the collection of data comprising a client personal information, a listing of all client tickets created during client ticket sessions initiated and carried out by the plurality of previous customers, a listing of repair orders processed by the plurality of dealers, comments entered by at least one of salespeople and sales managers, financing information and insurance information; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* § 2106.;

the combination of Stack and Geerlings does not explicitly teach statistically analyzing a collection of data that has been stripped of client confidential information and represents historical interactions between a plurality of sales entities and a plurality of previous customers. However, Kramer et al teaches removing confidential consumer information while still allowing targeted marketing to take place. It would have been obvious to one of ordinary skill in the art at



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the time of the invention to incorporate the removal of confidential consumer information, as a way to ensure customer information will not end up in the wrong hands.

As per **claim 2**, Stack and Kramer don't explicitly teach developing more than one recommended action item and automatically updating the electronic schedule with more than one task, wherein the electronic schedule is updated with a task that corresponds to each of the recommended action items. However, Geerlings teaches developing more than one recommended action item (column 5, lines 32-35 – the merchant schedules transmitting communications on recurring basis and column 6, lines 40-42 – reference is made to sending different communications to the same customer); and automatically updating the electronic schedule with more than one task, wherein the electronic schedule is updated with a task that corresponds to each of the recommended action items (column 5, lines 32-35 – the merchant schedules transmitting communications on recurring basis). It would have been obvious to one of ordinary skill in the art to include in the recommendation system of Stack the above recited features as taught by Geerlings since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 4**, Stack teaches developing at least one recommended action item to be taken with respect to a current customer based on at least one rule that is applied to the collection of data representing historical interactions with the plurality of previous customers (column 3, lines 50-65 – confidence matching factor is calculated to determine recommendations).

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As per **claim 5**, Stack and Kramer do not explicitly teach the limitations. However, Geerlings teaches developing at least one recommended action item to be taken with respect to a specific current customer based on a determination that the collection of data representing historical interactions with the plurality of previous customer shows that the specific current customer has not been contacted for a predetermined amount of time (column 5, lines 14-19 – the system analyzes how long ago a customer purchased a product in order to plan communication; if it has been more than 60 days since the purchase, communication is planned). It would have been obvious to one of ordinary skill in the art to include in the recommendation system of Stack the above recited features as taught by Geerlings since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 6**, Stack teaches determining at least one pattern demonstrated by a group of the plurality of previous customers (column 3, lines 50-65).

As per **claim 7**, Stack and Kramer teaches determining trends (Stack - column 3, lines 50-65), but does not teach the exact limitations of the claim. Geerlings teaches determining at least one trend based on environmental data characteristics (column 5, lines 6-9 – any combination of criteria based on age, gender, geographical location, shopping activity may be used to target the customer). It would have been obvious to one of ordinary skill in the art to include in the recommendation system of Stack the above recited features as taught by Geerlings since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of

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ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 8**, Stack and Kramer teaches determining trends (Stack - column 3, lines 50-65), but does not teach the exact limitations of the claim. Geerlings teaches determining at least one trend based on an environmental data characteristic selected from the group consisting of product type, product cost, customer target cost, customer gender, customer age, salesperson's gender, the weather and salesperson's age (column 5, lines 6-9 – any combination of criteria based on age, gender, geographical location, shopping activity may be used to target the customer). It would have been obvious to one of ordinary skill in the art to include in the recommendation system of Stack the above recited features as taught by Geerlings since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 13**, Stack teaches making recommendations based on interest and shopping history, but does not explicitly teach the features recited in the claims. Geerlings teaches the recommended action item includes selecting a timing and frequency for the at least one task (column 4, line 58 – column 5, line 5 – customer activity is analyzed and a plan is formulated by the merchant for desired customer communications, the plan including the desired communication (mail, email, internet, fax, etc.) and the date or timing of when the communication is to be sent). It would have been obvious to one of ordinary skill in the art to include in the recommendation system of Stack the above recited features as taught by Geerlings since the claimed invention is merely a combination of old elements, and in the combination

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each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per claim **26**, Stack and Kramer do not explicitly teach the features. Geerling teaches developing more than one recommended action item taken with respect to the current customer (column 5, lines 24-31 – communications include several forms wherein any combination of communications may be sent) based on a determination that the collection of data shows that the current customer has not been contacted for a predetermined amount of time (column 5, lines 33-40 - determination that an amount of time has lapsed, requiring contact of customer); automatically updating the electronic schedule with more than one task that corresponds to the more than one recommended action item )column 4, line 58 – column 5, line 5); and selecting a timing and frequency for the more than one task (column 5, lines 33-40 – timing schedule for communication).

### ***Claim Rejections - 35 USC § 103***

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. **Claims 17-20** rejected under 35 U.S.C. 103(a) as being unpatentable over Stack, US6782370, in view of Geerlings, US 5956693.

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As per **claim 17**, Stack teaches statistically analyzing a collection of data representing historical interactions between a plurality of dealers of a single sales entity with a plurality of previous customers that include at least one purchaser and at least one non-purchaser (column 1, lines 43-67 – collection of potential customer interest in a good and/or service and also collection of previous customer purchasing history; column 3, the system is a sales entity selling items from several different book companies (dealers); column 3, lines 50-65 – confidence matching factor is calculated to determine recommendations); developing at least one recommended action item to be taken with respect to a current customer based on results of the statistical analysis (column 1, lines 43-67 and column 2, lines 32-67 – interest data and purchasing data are analyzed to produce recommendations); performing a task that corresponds to the at least one recommended action item (column 3 – column 4 – books are recommended); wherein at least one of said at least one non-purchaser is other than said current customer and past purchasers (column 1, lines 43-67 – collection of potential customer interest in a good and/or service and also collection of previous customer purchasing history).

Further Stack teaches analyzing customer data, but does not explicitly teach the collection of data comprising a client personal information, a listing of all client tickets created during client ticket sessions initiated and carried out by the plurality of previous customers, a listing of repair orders processed by the plurality of dealers, comments entered by at least one of salespeople and sales managers, financing information and insurance information; however, these differences are only found in the non-functional descriptive material and are not functionally involved in the steps recited nor do they alter the recited structural elements. The recited method steps would be performed the same regardless of the specific data. Further, the

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structural elements remain the same regardless of the specific data. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, *see In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994); *MPEP* § 2106.

While Stack teaches generating recommendations (column 3 and 4), the reference fails to explicitly teach selecting an appropriate task type and automatically updating an electronic schedule with at least one task representing the at least one recommended action item. Geerlings teaches this feature (column 4, line 58 – column 5, line 5 – customer activity is analyzed and a plan is formulated by the merchant for desired customer communications, the plan including the desired communication (mail, email, internet, fax, etc.; column 4, line 58 – column 5, line 5 – customer activity is analyzed and a plan is formulated by the merchant for desired customer communications, the plan including the desired communication (mail, email, internet, fax, etc.) and the date or timing of when the communication is to be sent, rules for sending offers are based on the product purchased, i.e., if a customer purchases a certain appliance and extended warranty offer is sent to the customer and the date or timing of when the communication is to be sent). It would have been obvious to one of ordinary skill in the art to include in the recommendation system of Stack the scheduling of communications regarding the recommendations as taught by Geerlings since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

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As per **claim 18**, Stack teaches performing the task in response to a user directive (column 3, column 4 – recommendation in response to user actions).

As per **claim 19**, Stack teaches automatically performing the task (column 3 – 14-28 – once a user selects a book, the system automatically makes recommendations based on selection).

As per **claim 20**, it is the system with means for performing the method of claim 17. Since Stack teaches a computer system wherein customer data is analyzed to develop a plan for targeted communication the same rejection as applied to claim 17 is applied to claim 20.

### ***Conclusion***

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gottlich et al, US 6024288 – promotion system including an ic-card memory for obtaining and tracking a plurality of transactions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHNNA R. LOFTIS whose telephone number is (571)272-6736. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brad Bayat can be reached on 571-272-6704. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Johnna R Loftis/  
Examiner, Art Unit 3624